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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/643,224 | 08/20/2000 | Josephus Kuster | 64645-1025 | 8547 |
| 27045 | 7590 | 11/22/2004 | EXAMINER | |
| ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024 | | | KADING, JOSHUA A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2661 | |

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,224

Applicant(s)

KUSTER ET AL.

Examiner

Joshua Kading

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)* | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

The claims are objected to because they include reference characters which are not enclosed within parentheses.

5 Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

10 Claim 33, line 1 states "the first call control server 118". This should read --the first call control server (118)--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
15 form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

20 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

25 Claims 21-24, 26, 27, 29, 30, 32-34, and 36-39 are rejected under 35

U.S.C. 102(e) as being anticipated by Elliot et al. (U.S. Patent 6,614,781 B1).

Regarding claim 21, Elliot discloses "a method for establishing a packet communications link within a packet based communication network having a first call control server communicating with a first media gateway (figure 2B, soft switch 204 is the effective control server and gateway 232) and a second call control server communicating with a second media gateway (figure 2B, soft switch 304 and gateway 234) wherein said first media gateway provides communication link to a calling party terminal and said second media gateway provides communication link to a called party terminal, in response to a circuit switched call setup message (figure 2B, calling party 102 initiates the call to called party 120), comprising the steps of: providing a controlling signal from said first call control server to said first media gateway for establishing a first termination point for connecting said first media gateway with said calling party terminal (col. 27, lines 23-26) wherein said first media gateway further connecting said calling party terminal communicating circuit switched data to said packet based communications network (figure 2B, where the packet network is represented as the communication line between media gateways); generating a circuit switched call setup message from said first call control server to said second call control server associated with said called party terminal (col. 28, lines 36-45), said call setup message further including identification data associated with said first media gateway (col. 28, lines 48-52 where it is inherent that the call setup message contains address information, if it didn't the gateways would not be able to communicate with one another and setup a connection); providing a controlling signal from said second call control server to said

second media gateway for establishing a second termination point for connecting said second media gateway with said called party terminal (col. 28, lines 36-45) wherein said second media gateway further connecting said called party terminal communicating circuit switched data to said packet based communications network (figure 2B, where
5 the packet network is represented as the communication line between media gateways); and establishing a call specific packet communication link from said second media gateway to said first media gateway for communicating data between said calling party terminal and said called party terminal (col. 28, lines 48-52)."

10 Claim 36 contains similar claim language to that of claim 21. Although claim 36 is broader than claim 21, the corresponding limitations of claim 36 are rejected for the same reasons as claim 21.

Regarding claim 32, Elliot discloses "a packet based communication network
15 including a first media gateway for communicating with a first party terminal (figure 2B, elements 232 and 102), a first call control server for controlling said first media gateway (figure 2B, element 204) and a second media gateway for communicating with a second party terminal (figure 2B, elements 234 and 120), and a second call control server for controlling said second media gateway (figure 2B, element 304), said packet based
20 communication network comprises; means within said first call control server for instructing said first media gateway to establish a first termination point for communicating with said first party terminal (col. 27, lines 23-26) wherein said first

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media gateway receiving circuit switched data from said first party terminal and establishing a second termination point for communicating packet data including circuit switched data received from said first party terminal with said second media gateway over said packet based communication network in response to receiving a call setup request from said first party terminal towards said second party terminal (col. 28, lines 36-52); and means within said first call control server for generating a circuit switched based call setup message towards said second call control server wherein said call setup message includes identification data associated with said second termination point (col. 28, lines 36-45 where the setup message is sent to the second call control having information associated with the setup of the session and must contain identification information so that the gateways can setup the session)."

Regarding claim 22, Elliot discloses "the method of Claim 21 wherein the establishment of the first termination point further comprises the establishment of a third termination point within said first media gateway for communicating packet data with said second media gateway (col. 28, lines 48-52)."

Regarding claim 23, Elliot discloses "the method of Claim 22 wherein the establishment of the third termination point further comprises issuance of a response containing the information associated with the address of the third termination point from the first media gateway to the first call control server (col. 27, lines 26-27 where

the acknowledgement must have information regarding the address of the termination point so as to inform the soft switch what the acknowledgement is acknowledging)."

Regarding claim 26, Elliot discloses "the method of Claim 21 wherein the generation of a call setup message from said first call control server to said second call control server comprises transmitting a call setup message over a circuit switch network connection (figure 1 which is a more general picture of figure 2B and as seen the control servers 104 and 106 communicate through a signalling network using dedicated channels such as SS7, this can be read in col. 20, lines 5-14)."

Regarding claim 29, Elliot discloses "the method of Claim 21 wherein the establishment of the second termination point further comprises the establishment of a fourth termination point within said second media gateway for communicating packet data with said first media gateway (col. 28, lines 48-52 where the RTP session between the two gateways has a fourth termination point in the second gateway)."

Regarding claims 27, 33, and 37, Elliot discloses the methods of claims 26 and 36 and the network of claim 32. Elliot further discloses "said means for generating said call setup message generates an ISDN IS49 User Part (ISUP) signal over a circuit switch network connecting said first call control server with said second call control server (col. 20, lines 5-14 and col. 28, lines 36-37 where it is inherent that the servers

must first setup a connection to communicate and since SS7 is used, there is and ISUP message sent over the circuit switch network to establish this connection)."

Regarding claims 24, 34, and 38, Elliot discloses the methods of claims 23 and
5 36 and the network of claim 33. Elliot further discloses "further comprising UDP information associated with said second termination point within said first media gateway (figure 2B, path 284 shows the UPD information associated with the communication points between the gateways)."

10 Regarding claim 30, Elliot discloses "the methods of claim 29 wherein said establishment of said communication link comprises the step of establishing a third termination point within said first media gateway (col. 28, lines 48-52) and further establishing a link from said second media gateway to said first media gateway using said fourth termination point and said third termination point as two terminating
15 addresses (col. 28, lines 48-52 where the termination points must have terminating addresses or else the gateways could not connect)."

Regarding claim 39, Elliot discloses "the method of claim 36 wherein said second media gateway establishes a call specific packet communication link towards said first
20 media gateway using said second termination point as the destination address (col. 28, lines 48-52)."

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable
5 over Elliot et al.

Regarding claim 25, Elliot discloses the method of claim 23. However, Elliot does not explicitly disclose "wherein said third terminal point is further communicated from the first call control server to said second call control server within said generated call setup
10 message." Although it is not explicitly stated that the third termination point is sent using the call control servers, it is strongly implied that this must be the case in col. 28, lines 48-52. It would have been obvious to one with ordinary skill in the art at the time of invention to include the termination point addresses being communicated through the servers for the reason that in order for the gateways to establish communication their
15 respective termination points must be known, and since the call control servers have the established signalling channel available, the setup connection between the gateways must go through the servers initially. The motivation for having the setup go through the servers is to not use up data communication link resources with signalling data (col. 20, lines 5-14).

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Regarding claim 31, Elliot discloses the method of claim 21. However, Elliot does not explicitly disclose "wherein the issuance of said controlling signal from said first call

control server to said first media gateway comprises the issuance of an ADD message.”

Although the message sent from the server to the first media gateway is not defined as an “ADD” message, there are IPDC commands sent to establish a connection (col. 27, lines 23-26). It would have been obvious to one with ordinary skill in the art at the time

5 of invention to include the “ADD” message, or IPDC setup commands, for the purpose of establishing a connection between the gateway and the calling party. The motivation for doing this is so that the calling party has an access point to the network and is able to reach the called party.

10 Claims 28, 35, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al. in view of Christie (U.S. Patent 6,754,180 B1).

Regarding claims 28, 35, and 40, Elliot discloses the methods of claims 21 and 36, and the network of claim 32. However, Elliot lacks what Christie discloses, “wherein said means within said first call control server uses H.248 protocol over a packet based
15 link for instructing said first media gateway (col. 1, lines 42-51 where the “bearer path” indicates the protocol is used over the packet based link).” It would have been obvious to one with ordinary skill in the art at the time of invention to include the H.248 protocol for the purpose of eliminating the need to monitor the bearer path for DTMF tones. The motivation for doing so is to create a more efficient network.

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Response to Arguments

The objections to claims 33 and 38 have been withdrawn in light of applicant's amendments.

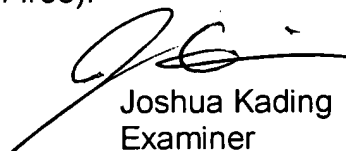
Applicant's arguments, see Remarks, section 3, filed 11 June 2004, with respect to the rejection(s) of claim(s) 21-40 under 35 U.S.C. 112 first paragraph (claims 21-40) and 35 U.S.C. 112 second paragraph (claim 30) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly discovered prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (571) 272-3070. The examiner can normally be reached on M-F: 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joshua Kading
Examiner
Art Unit 2661

10 November 15, 2004



BOB PHUNKULH
PRIMARY EXAMINER